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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/661,964

09/12/2003

Eldon L. Decker

1886A1

8568

7590

05/18/2006

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EXAMINER

AHMED, SHEEBA

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/661,964

Applicant(s)

DECKER ET AL.

Examiner

Sheeba Ahmed

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 37 is/are allowed.
- 6) ☒ Claim(s) 15-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Amendments to Claims*

1. Amendments to claims 15, 28, 31, and 35 have been entered in the above-identified application. Claims 1-14 are cancelled. New claims 36 and 37 have been added. **Claims 15-37 are now pending.**

The indicated allowability of the subject matter of dependent claims 20 and 32 has been withdrawn in light of the amendments made to claims 15 and 31 (upon which claims 20 and 32 depend, respectively) and the new rejection below. Any inconvenience to the Applicants is regretted.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 15-19, 21-31, and 33-36 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a coating composition comprising a resinous binder having dispersed therein colorants and reflective pigments wherein the pigments have a particle size of less than about less 150 nm and the coating composition exhibits a first appearance on face dominated by absorbance of light by the colorants and a second appearance on flop dominated by fluorescence of the colorants, does not reasonably provide enablement for a coating composition wherein the reflective pigments have a particle size greater than 150 nm and still

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exhibits a first appearance on face dominated by absorbance of light by the colorants and a second appearance on flop dominated by fluorescence of the colorants. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

Last paragraph on Page 5 states "the size of the pigment is selected so that the pigment particles will not scatter light effectively. Such scattering would induce significant diffuse reflectance that would be observed over a wide range of viewing angles. This would mask the fluorescence and diminish the change perceived in color with differing viewing angles". Page 6, first paragraph, further states that "a suitable primary particle size for the pigments is less than about 150 nm, or less than about 70 nm, or less than about 30 nm". Hence, pigment particle sizes of greater than 150 nm mask the fluorescence and do not exhibit a first appearance on face dominated by absorbance of light by the colorants and a second appearance on flop dominated by fluorescence of the colorants.

Claims 15, 35, and 36 has been amended to recite "wherein **when** the colorant comprises colorant pigments, the colorant pigments do not induce significant diffuse reflectance". However, the Examiner would like to point out that the use of the term "**when**" in this instance is the equivalent of stating that the colorant optionally comprises colorant pigments and not necessarily comprises colorant pigments. Hence, such a recitation does not limit the claim to comprising colorant pigments.

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3. Claims 15-27 and 31-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claims 15, 31, and 35 have been amended to recite that the "colorant pigments do not induce significant diffuse reflectance". However, there is no support for such a negative limitation in the original disclosure. The Applicants have directed the Examiner's attention to page 5 of the Specification which states that "the size of the pigment is selected so that the pigment particles will not scatter light effectively. Such scattering would induce significant diffuse reflectance that would be observed over a wide range of viewing angles. This would mask the fluorescence and diminish the change perceived in color with differing viewing angles". However, the Examiner takes the position that any negative limitation or exclusionary proviso must have basis in the original disclosure and that the mere absence of a positive recitation is not basis for an exclusion.

All new matter must be deleted in response to this Office Action.

***Allowable Subject Matter***

4. Claim 37 is allowed.

***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

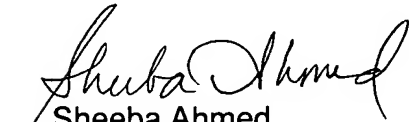
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheeba Ahmed whose telephone number is (571)272-1504. The examiner can normally be reached on Monday-Friday from 6am to 2pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571)272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Sheeba Ahmed  
Art Unit 1773  
May 15, 2006